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| APPLICATION NO.                 | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------|-------------|----------------------|---------------------|------------------|
| 10/616,102                      | 07/09/2003  | Hans Schmotzer       | MEISS71.007DV1      | 1655             |
| 20995                           | 7590        | 05/18/2006           | EXAMINER            |                  |
| KNOBBE MARTENS OLSON & BEAR LLP |             |                      | PELLEGRINO, BRIAN E |                  |
| 2040 MAIN STREET                |             |                      |                     |                  |
| FOURTEENTH FLOOR                |             |                      | ART UNIT            | PAPER NUMBER     |
| IRVINE, CA 92614                |             |                      |                     | 3738             |

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                |                     |  |
|------------------------------|--------------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b>         | <b>Applicant(s)</b> |  |
|                              | 10/616,102                     | SCHMOTZER ET AL.    |  |
|                              | Examiner<br>Brian E Pellegrino | Art Unit<br>3738    |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 27 February 2006.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-23 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/27/06 has been entered.

### ***Claim Objections***

Claim 23 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitation is already included in the independent claim from which it depends. Was the claim intended to depend from a different independent claim?

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims are 1,2,5,6,16,18,19,22 are rejected under 35 U.S.C. 102(b) as being anticipated by D'Antonio (5810831). Fig. 1 shows a slideway with two convexly curved condyles and inherently has a patella shield. Fig. 2 illustrates that the femur has two holes drilled for pegs located on the slideway. D'Antonio discloses that surgeons remove more bone from the dorsal side of the femur than replaced by the slideway, col. 1, lines 53-64. D'Antonio also discloses (col. 5, lines 40-42) using a template to size the femur and shows (Fig. 2) at least one bore 60 separated by a pre-determined distance. The use of "permanently specified distance" is terminology of relative degree, which has no basis of comparison. For this reason, it is considered broad and relatively unlimited in how it can be interpreted. It could be "a permanent measurement" for each patient that defines the "pre-determined distance". It is inherent that the surgeon is going to locate a point to drill a hole. It is also inherent that the slideway is fitted onto the femur and that pegs are inserted into the holes formed in the femur. The examiner is interpreting the claimed elements "unitary part of the template" in this way: an assembled device can be unitary. Claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974). See also *In re Morris*, Fed. Cir. 1997 127 F3d 1048, 1054,1055. For example in the military a "unit" is a group of soldiers. Thus, multiple parts can be assembled to be unitary.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 3,4,7,9-15,17,20,21,23 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Antonio '831. D'Antonio is explained supra. However, D'Antonio fails to disclose the pre-determined distance between the condyles and a point located on the femur being "about" 5-15% larger than the dimension of the between the peg and prosthesis condyles. It would have been an obvious matter of design choice to modify the amount of slideway surface provided for articulation, since applicant has not disclosed that using a larger amount provides any advantage, or solves a stated problem, or is used for any particular purpose. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with distance provided in the preparation of the femur taught by D'Antonio or the claimed 10% in claim(s) 4,10,21 because both procedures perform the same function of taking into consideration the anatomy conditions of the patient and the articulation of the prosthesis with respect to the ligaments. With respect to claim 7, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a slideway having about 2-5% dimension of a distance between a dorsal sliding surface and a ventral sliding surface, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable range involves only routine skill in the art. Regarding claim 17, it would have been obvious to one having ordinary skill in the art at the time the invention was made to resect about

10% more bone from the dorsal side of the femur, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. With respect to claims 11-15, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a distance between the peg and dorsal sliding surface of the slideway having a range between 24-34mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over D'Antonio '831 in view of Colleran et al. (5776201). D'Antonio is explained supra. However, D'Antonio fails to disclose providing a group of slideways with different dorsal condyle-to-ventral condyle distances. Colleran et al. teach (Fig. 4) a group of slideways is provided in a surgical procedure to prepare a femur for implanting a prosthesis. Colleran teaches the femoral prostheses are different sizes, col. 2, lines 54-56. It would have been obvious to one of ordinary skill in the art to use a plurality of femoral prostheses as taught by Colleran et al. in D'Antonio's method of surgery on a femur such that the surgeon has a proper fitting prosthesis for the patient since all patients are going to have different anatomical features.

#### ***Response to Arguments***

Applicant's arguments filed 2/27/06 have been fully considered but they are not persuasive. In response to applicant's argument that the D'Antonio reference fails to

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show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., non-detachable "contact surface portion" or locator feet ) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Additionally, Applicant argues that the distance between the bore and the contact surface is a permanently specified distance not disclosed by D'Antonio. However, any of D'Antonio's assembled templates used on a patient to size for the implant is going to result in providing a "permanent distance" between the locator feet and the bore holes because the bone surface is not changing until bone is removed. Applicant also argues that D'Antonio does not disclose the method of resecting more bone than replaced by the slideway. However, as mentioned above D'Antonio does disclose this step and states that more bone is removed than replaced by the implant condyles, (col. 1, lines 58-61) such that it provides for correcting for proper flexion in a deteriorating bone area, col. 2, lines 22-25,50-58, col. 5, lines 36-39.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E Pellegrino whose telephone number is 571-272-4756. The examiner can normally be reached on Monday-Thursday from 7am to 4:30pm. The examiner can also be reached on alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TC 3700, AU 3738



**BRIAN E. PELLEGRINO  
PRIMARY EXAMINER**